

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 In re Application THOMAS PING ) Primary Examiner: Cocks, J.  
HUA LEE ) Group Art Unit: 3749  
Serial No. 10/039,578 )  
Filed: 04/22/2003 ) Atty Docket No.: 01-10-1769  
10 Title: Safety Apparatus of a )  
Piezoelectric lighter )  
\_\_\_\_\_  
)

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20 May 11, 2005.

By: \_\_\_\_\_  
R. Joseph Trojan (Reg. No. 34,264)

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RESPONSE TO OFFICE ACTION DATED 04/05/05

Commissioner for Patents  
P.O. Box 1450  
30 Alexandria, Virginia 22313-1450

Sir/Madam:

This is a response to the Office Action dated April 05, 2005. The Applicant herein presents arguments to traverse the  
35 Examiner's 35 U.S.C. § 103(a) rejection.

I. RESPONSE TO 35 U.S.C. § 103 REJECTION:

The Examiner rejected Claims 7 and 8 under U.S.C. § 103(a) as being unpatentable over Buck (U.S. #4,850,854) in view of  
40 Mohr (US #3,984,738). According to the Examiner, in view of

Mohr, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the lighter of Buck to incorporate a pressure absorbing device that would provide an upward force additional to any upward force provided by the piezoelectric unit.

5 Applicant believes that this invention as presently claimed falls outside of the subject matter indicated, taught, or suggested by Buck in view of Mohr. According to MPEP § 706.02(j), "[t]o establish a prima facie case of obviousness, 10 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of 15 success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure." In re 20 Vaeck, 947 F.2d 488 (Fed.Cir. 1991).

In response, the Applicant respectfully traverses this rejection based on § 103(a) because neither the Buck reference, nor the Mohr reference, nor their combination, teach or suggest the limitations of claims 7 and 8.

A. THE BUCK REFERENCE TEACHES AWAY FROM THE INSTANT INVENTION.

The Examiner's rejection focuses on Figure 3 of the Buck disclosure and states that the disclosure in Figure 3 is 5 substantially similar to that described in Applicant's claims 7 and 8.

A reference must be considered as a whole, including the portions that argue against or teach away from the claimed invention. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448 (Fed. Cir. 1986). A reference teaches away from an invention when a person of ordinary skill "would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

The Buck reference indicates that the critical problem of 15 children using cigarette lighters can be overcome by three ways: (1) eliminating an "open" flame; (2) incorporating a design which prevents ignition of the fuel unless the cigarette is filling the well or tube; and (3) extinguishing the flame when the lighted cigarette is withdrawn from the well or tube. See 20 Col. 2, lines 1-12. The Applicant's invention, however, in claims 7 and 8, include the use of a pressure absorbing device to impede movement of the thumb push cap (or alternatively referred to as an "activation button"), which acts as a child safety apparatus. This impeded movement is in addition to the

upward force provided by the piezoelectric unit. The *Buck* reference makes no reference to a pressure absorbing device, and, therefore, suggests a different solution than the one eventually discovered by the Applicant.

5 A critical aspect of the Applicant's invention is the use of a pressure absorbing device to impede movement of the thumb push cap. The Examiner stated that *Buck* discloses a pressure absorbing device, namely the unnumbered spring to the right of pivot 84 in Fig. 3. The "unnumbered spring", however, does not  
10 impede the movement of the thumb push cap, and was not designed to provide any upward force. The three safety features provided for in the *Buck* reference do not include or mention the "unnumbered spring" as a safety feature. Its sole purpose is to act as a lever pivot, not to act as a child safety device to  
15 impede movement of the thumb push cap. The fact that *Buck* has a spring is not conclusive. The novel feature of the present application is the use of a pressure absorbing device in addition to the conventional mechanisms for providing an upward force, such as a spring, contained in the prior art that  
20 typically keeps the activation button in an upward position. This is not disclosed in the *Buck* reference.

The disclosure in *Buck* clearly teaches away from Applicant's invention because the whole purpose of the invention described in *Buck* is achieved without the use of a pressure

absorbing device. Buck does not teach the use of a pressure absorbing device to impede movement of the activation button that acts in addition to the upward force provided by conventional mechanisms in a piezoelectric unit. The additional 5 upward force provided by the pressure absorbing device represents the novel and distinguishing feature not found in the prior art. Hence, it is respectfully submitted that the present application is not obvious over Buck.

B. NO SUGGESTION EXISTS IN THE REFERENCES NOR KNOWLEDGE

10 AVAILABLE TO THOSE SKILLED IN THE ART THAT SUGGESTS  
COMBINING BUCK AND MOHR.

With respect to the combination of Buck and Mohr, there is no suggestion in the references nor knowledge available to those skilled in the art that suggests combining the references. 15 "[A] reference ... is only good for what it clearly and definitely discloses." In re Moreton, 288 F.2d 708 (C.C.P.A. 1961). Furthermore, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the Applicant's claims. ACS Hospital 20 Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination").

In this instance, there is no teaching or suggestion in either the *Buck* or *Mohr* references relied on by the Examiner that suggests combining the two references. Therefore, unless there is knowledge available to one of ordinary skill in the art 5 suggesting such a combination, the *Buck* and *Mohr* references may not be combined to form an obviousness rejection.

It is well settled that "[w]hether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of 10 ordinary skill in the art." In re Free, 329 F.2d 998 (C.C.P.A. 1964). Therefore, either the *Buck* reference or the *Mohr* reference must reasonably and realistically teach or suggest to those of ordinary skill that the two references should be combined with each other. A review of these two references 15 shows that such a teaching or suggestion cannot be found.

The *Buck* invention specifically relates to a child-resistant cigarette lighter by eliminating an "open" flame, preventing fuel ignition unless the cigarette is filling the wall or tube, and extinguishing the flame when the lighted 20 cigarette is withdrawn from the well or tube.

The *Mohr* disclosure, on the other hand, serves an entirely different purpose. Though the Examiner stated that *Mohr* was cited simply to provide a description of a piezoelectric unit, *Mohr* has nothing to do with a child resistant cigarette lighter.

Mohr simply discloses a piezoelectric lighter, and does not teach or suggest the use of a child safety apparatus for a cigarette lighter. Accordingly, the Buck and Mohr devices are used for different purposes, and there is no reasonable nor 5 realistic teaching or suggestion to those of ordinary skill that Buck should be combined with Mohr.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an Applicant's claims are obvious. The law 10 does not sanction such a piecemeal construction of the prior art. In re Kamm & Yo, 452 F.2d 1052 (C.C.P.A. 1972) ("a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure shall not be the basis for a holding of obviousness"). See also, In re Newell, 891 F.2d 899, 901 (Fed. 15 Cir. 1989) ([a] retrospective view . . . is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination"). As hindsight reconstruction is not proper, these references cannot be combined in order to form a 103(a) 20 rejection.

C. APPLICANT'S CLAIMS GO BEYOND ANY REASONABLE COMBINATION OF BUCK IN VIEW OF MOHR.

Even if the Examiner finds that there is some suggestion to those of ordinary skill in the art to combine the two

references, the references when combined must teach or suggest all the claim limitations. In this instance, Applicant's claims 7 and 8 go beyond any reasonable combination of the prior art references.

5 As asserted above, *Buck* does not suggest or teach the use of a pressure absorbing device to act as a child safety apparatus. The Examiner asserts that from *Mohr*, it is understood that the piezoelectric unit inherently provides an upward force. While this is true, the limitations of claims 7 and 8  
10 incorporate the pressure absorbing device, and the Applicant has already traversed in detail why the *Buck* patent does not teach the use of a pressure absorbing device to act as an upward force to impede movement of the thumb push cap, in addition to the conventional spring.

15 Therefore, even assuming that *Mohr* may be combined with *Buck* to disclose the use of the piezoelectric unit to act as an upward force for a child safety device, since *Mohr* fails to disclose the other limitations of claim 7 and 8, namely the use of a pressure absorbing device capable of impeding movement and  
20 transmitting an additional upward force (as discussed in Section I(a) and (b) above), *Buck* in combination with *Mohr* fails to teach all of the limitations of claim 7 and 8. Consequently, as neither *Buck* nor *Mohr* teaches that which is in Applicant's claims 7 and 8, either singly or taken together in any

reasonable combination, Applicant submits that claims 7 and 8 are allowable over Buck in view of Mohr.

II. CONCLUSION:

- 5 In light of the above arguments, the Applicant respectfully requests reconsideration of claims 7 and 8. The Applicant believes the pending claims represent allowable subject matter. Specifically, Applicant believes that claims 7 and 8 are not obvious in light of Buck as applied to Mohr.
- 10 If any additional fees are required for this response, the Director is authorized to deduct the required amounts from our deposit account no. 500703.

15 Respectfully Submitted,

TROJAN LAW OFFICES

By

Dated: May 11, 2005

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